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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,509	09/10/2003	Ronald J. Nachman	0166.03	3643

25712 7590 10/03/2005

USDA-ARS-OFFICE OF TECHNOLOGY TRANSFER
NATIONAL CTR FOR AGRICULTURAL UTILIZATION RESEARCH
1815 N. UNIVERSITY STREET
PEORIA, IL 61604

EXAMINER

BORIN, MICHAEL L

ART UNIT PAPER NUMBER

1631

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/659,509

Applicant(s)

NACHMAN ET AL.

Examiner

Michael Borin

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07/20/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 and 20-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 14-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3 IDSs.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RD

DETAILED ACTION

Status of Claims

1. Claims 1-40 are pending.

Response to restriction requirement filed 07/20/2005 is acknowledged. Applicant elected, with traverse Group I, claims 1-15. With respect to Groups I and IV, Applicant's arguments were considered and are deemed to be persuasive. With respect to Groups II,III, V,VI, applicant states that claims 20-30 were canceled in the original request for filing patent application, filed 09/10/2003. No such cancellation is identified in said document. Neither claims 31-40, which are not addressed in applicant's response, have been canceled previously. Applicant is invited to cancel claims 20-40. With respect to election of species, applicant elects carborane derivative (p. 2 of response) and informs that claims 1-3,14,15 read on the elected species. Claims 4-13 are withdrawn from consideration.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-3,14-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection is applied for the following reasons:

Art Unit: 1631

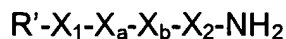
A. Claim 1, part (iv). It is not clear whether X_1 and X_2 radicals have the same meaning as defined for other moieties in the beginning of the claim. If it has different meaning, the meaning is not defined in the claim.

B. Claim 1, part (iv): The phrase "said polypeptide group is sufficiently small as to retain the hydrophobicity of said compound introduced by said hydrophobic moiety" is not clear. First, it is not clear which "said hydrophobic moiety" is meant. Second, the term "sufficiently small" with respect to the size of polypeptide group, is a relative term, and it is failing to particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.

Double Patenting

3. Claims 1-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-40 of copending Application No. 10/659233. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

4. Claims 1-3,14,15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of US 6,664,371. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 6,664,371 claims are directed to compounds of the formula



Art Unit: 1631

wherein X_a-X_b is Phe-Gly, and R' can be carboranyl derivative. The latter values of R' read on the instantly claimed compound with N-terminal hydrophobic moiety as defined in claim 1.

5. Claims 1-3,14,15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3,5-17 of U.S. Patent No. 6,207,643. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 6,207,643 claims are directed to compounds of the formula



wherein R' can be a Phe, Tyr or hydroxycinnamyl group. The latter values of R' read on the instantly claimed compound with N-terminal hydrophobic moiety as defined in claim 38(b).


6. Claims 1-3,14,15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-40 of copending Application No. 10/385317 or over claims 1-40 of copending Application No. 10/659233. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are directed to alatostatin derivatives wherein X_a-X_b is Phe-Gly, and R' can be carboranyl derivative.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (571) 272-0713. The examiner can normally be reached on 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel, Ph.D., can be reached on (571) 272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

 Michael Borin, Ph.D.
Primary Examiner
Art Unit 1631

mlb